REMARKS

Claims 1-71 were pending in the present application. By virtue of this response, Claims 5, 6, 19, 20, 31, 32, 56, 57, 63 and 64 have been cancelled, Claims 1, 15, 27, 47, and 59 have been amended. Accordingly, Claims 1-4, 7-18, 21-30, 33-55, 58-62 and 65-71 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Claim Rejections/Objections

Claims 1-5, 7-11, 13-19, 21-23, 25-31, 33-36, 39-43, 45-57, 58-64, 65-68 and 70-71 stand rejected under 35 U.S.C. § 102(b) as anticipated by Sako et al. (JP 09-098381).

Claims 6, 20, 32, 37, 38, 57 and 64 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sako et al. as applied above, and further in view of Kawara et al. (6,278,836).

Claims 12, 24, 44 and 69 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sako et al. and further in view of Quan (6,421,497).

Claims 47 and 51 were objected to for reciting "encoder." The objection is traversed; Claims 47 and 51 read on Fig. 4A, decoder 65, see specification paragraph 59. The decoder decodes the digital video from the analog to digital converter.

Rejections are Believed to Be Inconsistent

The Examiner rejected dependent Claims 5 and 6 on different grounds. Claim 5 was rejected under § 102 as anticipated by Sako et al. Claim 6 was rejected separately under § 103 as being obvious in view of Sako et al., plus Kawara, see paragraph 5 of rejection.

It is believed these rejections are inconsistent. Specifically, the Examiner stated regarding Claim 6 in paragraph 5 "Sako et al....do not specifically disclose that characteristic as

being for how long to allow subsequent digital storage. Kawara et al. teach the inclusion of record prevention data based on a time period for allowable reproduction..."

This contradicts the rejection of Claim 5 where the Examiner stated in the Action at the bottom of page 4 "Regarding Claims 5 and 9, Sako et al. disclose a method of an apparatus for encoding an analog video signal, wherein the at least one characteristic defines the encoded pattern which specifies: an off state; an indication of allowing digital storage; and an indication of how long to allow the digital storage (paragraph 0031...)".

These rejections are believed to be inconsistent because the subject matter of Claim 6 is also recited in the final clause of Claim 5. Applicant respectfully submits that the rejection of Claim 5 as anticipated under § 102 was incorrect. For consistency the Examiner needed to cite Kawara to meet the subject matter of Claims 5 and 6.

As an alternative, possibly the Examiner is construing each clause of Claim 5 as being an exclusive (or) clause. But that is not the way Claim 5 is written.

Hence it is respectfully submitted that the Examiner in rejecting Claim 5 to be consistent should have recited Kawara, in addition to Sako.

Rejections Traversed

It is respectfully submitted, however, that even Kawara in combination with Sako fails to meet the subject matter of Claims 5 or 6. These claims read on the specification at page 6, paragraphs 25-27, defining three control states conveyed by the encoded pattern in accordance with this invention. In paragraph 25, state 1 is an indication of setting the amount of storage time that a PVR can (digitally) store video. In paragraph 26, state 2 is an indication of do not store, that is not allowing copying of video. In paragraph 27, state 3 corresponds to provision of a 90-minute duration of PVR storage for a particular program. These correspond to the three states recited in original Claim 5 and the one state of Claim 6.

Kawara

This reference, contrary to the Examiner's indication, does not meet Claim 5 or Claim 6. The Examiner cited Kawara et al. column 3, lines 6-9 against Claim 6, see above. It is respectfully submitted that the Examiner misconstrued Kawara. First, Kawara (translated from a Japanese patent document) refers in this passage to "reproduction". It is respectfully submitted that "reproduction" in this context means playing, not recording. In other words, Kawara is a method of restricting playback. This corresponds therefore at most only to state 1, which is the off state of Claim 5, where no copying is permitted. In this case, Kawara prevents copying by preventing playing.

That "reproduction" in Kawara means "playing" is made clear for instance in the Background of the Invention of Kawara column 1, beginning line 54 "Under such circumstances, even though the media provide the same software, reproduction control to inhibit or restrict the use of the software, i.e., viewing of a movie or reproduction of a computer program, in each area has been increasingly demanded by software markers." (Emphasis added.) Reproduction here clearly means of viewing or playing or using. With regard to a computer program, obviously computer programs are not played, but they are used or executed. Kawara uses the general term "reproduction", referring to viewing or playing or executing.

This meaning is made clear in the following paragraph under Summary of Invention of Kawara beginning column 1, line 61 "It is an object of the present invention to provide an information reproducing apparatus that can perform, for each area, reproduction restriction of information that is recorded on media such as optical disks and available by reproduction, thereby enabling a use of a software, such as a movie or a computer program, from a given time or within a given period of time corresponding to each area." (Emphasis added.) Again, here "reproduction restriction" refers to playback (use) restriction since the subsequent part of this sentence refers to "enabling a use of a software, such as a movie or computer program". Hence reproduction restriction does not mean copying, but instead playback. (Of course if something is not played back, it also can not be copied.)

In that sense, it is understood that Kawara discloses here shutting off playing, which may correspond in present Claim 5 to the off state. That is, as defined in the present specification in paragraph 26, state 2 is an indication of do not store (do not allow copying of) the video. Obviously if something cannot be played, it cannot be stored. However, rather than actual controlling downstream copying, Kawara takes the simpler approach of merely inhibiting playing in the context of his particular playback apparatus.

Present Invention

In contrast, the present invention is not directed towards controlling playback or copying in the apparatus which is doing the initial playing. Instead it controls the downstream use of the played video by another apparatus. That is because in accordance with the present invention, the video is converted to analog form and the analog video is output. In fact in accordance with the present invention, there is nothing to prevent actual playing of this analog signal regardless of the control state. Instead the intention is to prevent or control downstream copying when that analog signal is subsequently reconverted to digital form. In accordance with the invention, this analog video carries the encoded information which when that analog video signal is reconverted into digital form, controls its use.

Instead Kawara is only concerned with preventing playback within his particular reproduction apparatus rather than what happens to the video downstream. Once his video is played, he exerts no control over it.

Further Kawara, even if he meets the first element of Claim 5 which is the "off state", fails to meet the other two elements of Claim 5 which are allowing "subsequent" digital storage at all and if digital storage is permitted, how long to allow that subsequent digital storage to persist. Instead as pointed out above, Kawara merely allows reproduction (replay) or not. There is no control of downstream digital storage of an analog output signal. Instead the control in Kawara is strictly for play of the current digital signal.

Claims Distinguish Over Kawara

Hence the subject matter of original Claim 5 distinguishes over Kawara for several reasons. First, Kawara defines only one control state rather than three states. Second, his control is only over current playback, not downstream or "subsequent" storage. Third, his control is only of the replay itself and is not of any "subsequent digital storage" or for how long to allow storage.

Claim 1 is amended to include the subject matter of Claim 5 with language added to further clarify Claim 5. Hence Claim 5 has been canceled and the final clause of Claim 1 now recites "wherein the at least one characteristic defines the encoded pattern which specifies the three states of:

an off state;
an indication of allowing subsequent digital storage; and
an indication of how long to allow subsequent digital storage."

As pointed out above, this feature is not shown or suggested in Kawara, which instead is restricted to control of current playback and at most therefore might meet the first element ("off state") of Claim 5, but not the other two. Moreover it is pointed out that the three states of Claim 5 are defined by the encoded pattern, which at any one time takes any one of these. Hence Claim 1 as amended is directed to an encoding system with the three recited states. Kawara at most only has the one state.

Hence Claim 1 clearly distinguishes over Kawara, even in combination with Sako.

Moreover as pointed out above, the Examiner rejected Claim 5 as reading on Sako paragraph 31. While (see above) the Examiner admitted this is not really the case since he also cited Kawara in rejecting Claim 6, it is respectfully submitted that Sako paragraph 31 also does not meet Claim 5.

As regards Sako, the corresponding U.S. patent document is believed to be U.S. patent 6,108,423, having the same inventors and the same Japanese priority dates. Paragraph 31 of the

Sako Japanese patent document machine translation corresponds to Sako U.S. 6,108,423 column 6, beginning line 36 "It may be contemplated to allocate only the bit b2 as a bit CM_M specifying that the copying be inhibited or not inhibited." This is clearer than the machine translation. It makes it clear that bit b2 allows copying or not.

See also the prior paragraph of Sako at column 6, beginning line 23, which corresponds to the machine translation paragraph 30 and states "The copying management information for this case may be made up of eight bits b7 to b0 as shown in FIG. 2. Of these eight bits, the upper two bits b7 and b6 are allocated as a bit CM_C instructing generation limitation, while the three lower bits b2, b1 and b0 are allocated as bits CM_M instructing copying inhibition of both digital and analog data or only of digital data." (Emphasis added.)

Again it is clear here that Sako is directed to allowing copying or not, either a single copy or generational copies. Generational copy control is directed to determining how many generations of copies are made. But generational copy control does not control how long any of those copies may persist, and generally they have no limitation on how long they can persist. So there is no indication in Sako of anything pertaining to subsequent digital storage, or the duration (persistence) of any subsequent digital storage.

Hence it is clear that subject matter of Claim 5, canceled and now included in Claim 1, distinguishes over Sako, and also over Sako in combination with Kawara. Hence Claim 1 is allowable.

Other Claims

Each remaining independent claim is amended essentially identically to Claim 1. These are Claims 15, 27, 47 and 62, and so they each distinguish over the references for at least the same reasons as pertain to Claim 1.

All remaining claims are dependent upon one of these independent claims and hence allowable for at least the same reason as the respective base claim.

CONCLUSION

In view of the above, all presently pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Attorney Docket No. 136922003400. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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